

## REMARKS

A Terminal Disclaimer over co-pending application 09/196,262 is attached. This overcomes the rejection set forth in paragraphs 1, 2, 3, 4, and 5.

With respect to the statement on page 6 of the office action, the inventor of the earlier filed application is the prior inventor of any alleged conflicting subject matter. However, the applications 09/196,262 and 09/474,216 were commonly owned at the time the inventions in each application were made.

Claims 51-53 were rejected as anticipated by De Saint Marc.

However, claim 51 calls for providing a video segment from one video transmission for display in the course of the second video transmission. This plainly does not occur in De Saint Marc as indicated in column 9, lines 30-38. There it is made clear that when the operator determines that a goal is scored and an event transmitted on a given channel, viewers that are not watching that channel may be provided with an icon indicating the imminence of a goal. The user then either does nothing or must change the channel to the channel where the other event is being broadcast. This plainly does not correspond to providing a video segment from one video transmission for display "in the course of the second video transmission." Requiring the user to change channels does not meet the claim limitation. Therefore, reconsideration of the rejection of claims 51-53 is respectfully requested.

Claim 31 was rejected under Section 103 over the combination of De Saint Marc in view of Cragun.

Claim 31 calls for monitoring one video transmission while the receiver is tuned to another video transmission. It also calls for monitoring for a predetermined time associated with the one video transmission and generating a notification at a predetermined time associated with the one video transmission. The office action takes official notice that, since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input a time in order to monitor for that time. The taking of official notice of obviousness is plainly improper. To the extent that the Board of Appeals may disagree that this taking of official notice is improper, the Applicant respectfully calls on the Examiner to show a reference that shows this obviousness.

In short, there is nothing in Cragun that suggests monitoring for a predetermined time associated with one video transmission or generating a notification at the predetermined time.

There is nothing inherently obvious about the claim limitation and inherent obviousness is not a concept recognized within the patent law.

In order to make out a *prima facie* rejection, a rationale must be provided from within the prior art itself to modify the references. Here, neither reference or their combination teaches the claimed limitations and the attempt to use official notice to supply what is plainly missing from the references is unavailing. Therefore, reconsideration of the rejection of claim 31 is respectfully requested.

With respect to the taking of official notice with respect to dependent claim 32, it is again questioned whether or not official notice can be taken of obviousness and to the extent that the Board of Appeals disagrees, the Examiner is respectfully requested to make a showing from the prior art.

With respect to claim 35, for the reasons already stated, claim 35 patentably distinguishes over the cited references. Again, the taking of official notice is questioned and to the extent that it is considered to be appropriate, the Examiner is respectfully requested to make a showing from the prior art.

The same arguments apply to claim 39 and its dependent claims.

Claim 42 calls for monitoring one video transmission while a receiver is tuned to receive another video transmission and generating a notification when a predetermined score is detected during the one video transmission. This claim is rejected over a combination of De Saint Marc and Cragun.

Again, there is nothing in either reference that teaches monitoring for a score. The taking of official notice that Cragun suggests obviousness is again challenged and it is requested to the extent that it is considered to be appropriate to take official notice of obviousness, that the Examiner is respectfully requested to cite a reference. In the meantime, absent the citation of a reference, a *prima facie* rejection is not made out. The same arguments apply with respect to the claims dependent on claim 43 and claims 45 and 48. The taking of official notice with respect to claim 45 is again challenged.

Claim 54 was rejected over De Saint Marc in view of Cragun.

Claim 54 calls for an article that stores instructions that, if executed, enable a processor-based system to monitor one video transmission while the receiver is tuned to receive a second video transmission, to detect the occurrence of an event in the course of one video transmission

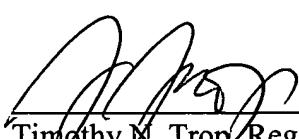
and provide a video segment from one video transmission for display in the course of a second video transmission. Of course, contrary to the Examiner's suggestion that De Saint Marc teaches monitoring one video transmission while the receiver is tuned to another video transmission, De Saint Marc plainly teaches using an operator at a remote location to do so. This does not teach an article storing instructions that enable a processor-based system to do the same thing. For the same reason, De Saint Marc does not teach an article storing instructions that, if executed, enable a processor-based system to detect the occurrence of an event in the course of one video transmission.

Cragun fails to teach software that provides a video segment from one video transmission for display in the course of a second video transmission. The argument that De Saint Marc and Cragun, neither of which teach the claimed limitation, can somehow be combined to teach the claimed limitation is unavailing. There must be some teaching of the automation of the claimed step which is plainly lacking. Moreover, there is total absence of the claim step within the limitation as recognized in other rejections. Namely, neither Cragun nor De Saint Marc teach software that provides a video segment from one video transmission for display in the course of a second video transmission as explained with respect to the rejection of claim 51.

For the same reason, claim 57 patentably distinguishes over the art. There is no teaching of any computer system in either Cragun or De Saint Marc that has the claimed limitations.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested.

Respectfully submitted,



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